

Office Action Summary**Application No.**

10/517,492

Applicant(s)

BURCHARD, THEO

Examiner

David J. Joy

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-12 and 14-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3-9 and 11 is/are allowed.
- 6) ☒ Claim(s) 10, 12 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 20090313
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 3-12 and 14-19 are pending as amended on February 17, 2009, with Claim 13 having been cancelled, and Claim 2 having been previously cancelled.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 17, 2009 has been entered.

Response to Amendment

4. Applicant's amendment to Claim 6, in the amendment filed on February 17, 2009, renders the previously cited rejection under 35 U.S.C. §112 moot. As such, the rejection

of Claims 6 and 7 under 35 U.S.C. §112, second paragraph, as being indefinite, has been withdrawn.

5. Applicant's amendment to Claim 12, in the amendment filed on February 17, 2009, obviates the previously cited rejection under 35 U.S.C. §102. Therefore, the rejection of Claims 12-19 under 35 U.S.C. §102(b), as being anticipated by the U.S. Patent of Edwards (5,093,184), is withdrawn.

6. Applicant's assertions, in the amendment filed on February 17, 2009, obviates the previously cited rejection under 35 U.S.C. §103. The rejection of Claim 1 and 3-11 under 35 U.S.C. §103(a), as being unpatentable over Edwards, in view of the U.S. Patent of Pollock (3,601,913) and the U.S. Patent of Solomon et al. (4,536,016; hereinafter "Solomon") has been withdrawn.

7. Applicant's assertions, in the amendment filed on February 17, 2009, whereby the Office was apprised that Claims 1-5, 16, 18-20 and 24 of formerly-copending Application No. 10/498,872 (which corresponds with U.S. Patent Application Publication No. 2005/0012326) have been cancelled by the amendments filed on August 29, 2008 in that case, renders the previously cited provisional rejection of the claims

moot. As a result, the provisional rejection of Claims 12-19, on the ground of nonstatutory obviousness-type double patenting, has been withdrawn.

Claim Objections

8. Claims 1, 3-12 and 14-19 are objected to because of the following informalities:
 - a. Each of Claims 1, 3-12 and 14-19 lacks the appropriate article that should appear in the preamble of each claim (be it an *indefinite* article like “A” or “An” or a *definite* article like “The”);
 - b. Additionally, regarding Claim 5, the claim recites “the first &or second carrier foil” in Line 3 of the claim, as opposed to “the first *and/or* second carrier foil”;
 - c. Also, in Claims 16-18, which all depend upon either Claim 14 or 15, the references back to the *security element* of either Claim 14 or 15 should be to *the multilayer security element* of those Claims; and,
 - d. In Claim 18, Line 1 of the claim recites “security element *accordingly* to claim 15” whereas it should recite “security element *according* to claim 15.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. Claims 10, 12 and 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

- a. Claim 10 is indefinite because it recites "that the layer compound of divided into *so-called* endless threads or endless strips."
- b. Claim 12 is indefinite because the claim is drawn to a "Layer compound produced by the method according to claim 1 or 11". However, while Claim 1 is drawn to a "Method for producing a layer compound", Claim 11 is drawn to a "Method for producing a security element."
- c. Claim 18 is indefinite because it recites that an object "is *firmly* joined by" several different modes of attachment, without providing any clarification as to what degree of joining would qualify as being *firmly* joined.

10. Claims 14-19 are rejected accordingly, as they all depend upon Claim 12 (although Claim 18 is also rejected for the separate reason discussed hereinabove).

Claim Rejections - 35 USC § 102/103

11. Claims 12 and 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Edwards.

12. Edwards teaches a multilayer security element having two carrier foils that have security features thereon that only partially cover the foil, and that the carrier foils are joined so that the security features are in precise register to each other (see Abstract; see also Figure 12; see also Column 2, Lines 1-27; see also Column 8, Lines 18-30). Edwards also teaches that the carrier foils have register marks, which are different features than the security features provided by the foils (see Column 2, Lines 11-48). Specifically, Edwards provides that the security element contains two metallic areas, which are visually detectable (*Id.*). Additionally, when the security element is viewed in reflected light, there is a repeating pattern along the length of the element that is visible and that appears to be in several different colors (see Column 2, Lines 11-48; see also Column 3, Lines 18-42; see also Column 4, Lines 14-28; see also). Further, Edwards teaches that the multilayer security element can be a strip or thread, that the element is embedded within a security paper, and that the security paper can be used to make bank notes, checks, and other similar documents (see Abstract; see also Column 1, Lines 5-18 and 64-68; see also Column 4, Lines 60-63). If there is any difference between the product of

Edwards and the product of the instant claims, the difference would have been minor and obvious.

13. Claims 12 and 14-19 are viewed as product-by-process claims and hence the method they are created by is not pertinent, unless Applicant can show a different product is produced. Although Edwards does not disclose joining the first carrier foil to the second carrier foil, with at least one of the two carrier foils being under tensile stress, where at least one of the carrier foils is being controlled in the longitudinal direction and the transverse direction with the help of the first and second register marks, and in which the first and second security features are disposed in register to each other, where the controlling of one of the carrier foils is effected by stretching the carrier foil in the longitudinal direction, it is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. "If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102."

In re Best, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (C.C.P.A. 1977). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP §2113.

14. Therefore, absent sufficient evidence of criticality regarding the presently claimed process and given that Edwards meets the requirements of the claimed layer compound, Edwards clearly meets the requirements of present Claims 12 and 14-19.

Response to Arguments

15. Applicant’s arguments regarding Claims 1 and 3-11, filed February 17, 2009, with respect to the teachings of Edwards in view of Pollock and Solomon, have been fully considered and are persuasive. The previously cited rejection of the claims has been withdrawn, as addressed hereinabove. Likewise, Applicant’s arguments regarding the provisional rejection of Claims 12-19, on the ground of nonstatutory obviousness-type double patenting, have been fully considered and are accurate, so the previously cited provision rejection of the claims has been withdrawn, as discussed hereinabove.

16. Applicant's arguments regarding Claims 12-19, filed February 17, 2009, with respect to the rejection of Claims 12-19 under 35 U.S.C. §102(b), as being anticipated by Edwards, have been fully considered and are not persuasive. However, Applicant's amendment to Claim 12 obviated the previously cited rejection and necessitated the new grounds of rejection.

17. Applicant argues that Edwards fails to disclose any laminated security elements which have different stress-related characteristics, thus Claim 12 is not anticipated by Edwards since it fails to disclose each and every element of Claim 12, which is inherent from its claim language. However, Examiner disagrees with this assertion. The newly-amended Claim 12 is now a product-by-process claim (as discussed hereinabove), and even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. Furthermore, "once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to Applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

Allowable Subject Matter

18. Claims 1, 3-9 and 11 are allowed. Claim 10 contains allowable subject matter, but is rejected for the reason discussed hereinabove. The reason that the claims are indicated as being allowed is that none of the prior art references of record teach or suggest a method for producing a layer compound having at least two security features and comprising a first carrier foil with at least one first security feature and first register marks and a second carrier foil with at least one second security feature and register marks, that requires the steps of joining the first carrier foil to the second carrier foil, with at least one of the two carrier foils being under tensile stress, at least one of the carrier foils being controlled in the longitudinal direction and the transverse direction with the help of the first and second register marks, and in which the first and second security features are disposed in register to each other, where the controlling of one of the carrier foils is effected by stretching the carrier foil in the longitudinal direction.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DJJ/
Examiner, Art Unit 1794
03/13/2009

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794